



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,197	03/20/2001	Kenneth J. Rothschild	AMBER-06311	7465

23535 7590 09/10/2003

MEDLEN & CARROLL, LLP  
101 HOWARD STREET  
SUITE 350  
SAN FRANCISCO, CA 94105

EXAMINER

LAMBERTSON, DAVID A

ART UNIT	PAPER NUMBER
----------	--------------

1636

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/813,197

Applicant(s)

ROTHSCHILD ET AL.

Examiner

David A. Lambertson

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1636

## **DETAILED ACTION**

### ***Priority***

Applicant's claim for domestic priority to US Patent No. 6,306,628 under 35 U.S.C. 120 is acknowledged.

### ***Information Disclosure Statement***

The information disclosure statement filed January 15, 2002 as Paper No. 8 has been considered, and a signed and initialed copy of the form PTO-1449 is attached to this Office Action.

### ***Specification***

The disclosure is objected to because of the following informalities:

The specification repeatedly refers to "BODIPY", yet there is no definition of what the acronym stands for. Applicant must clearly indicate what an acronym represents upon its first appearance in the specification.

On page 94, starting on line 3, the specification makes the following statement: "To the above aminoacylated-tRNA solution, 2.5 (1 of 1N NaHCO<sub>3</sub> was added (final conc. 50 mM, pH=8.5) followed by 10 (1 of 10 mM solution of BODIPY-FL-SSE (Molecular Probes) in water." It is unclear what this statement means for several reasons: (a) "2.5" what (i.e., milliliters, grams, moles, etc.) is being added; (b) what is meant by 1 of 1N of NaHCO<sub>3</sub>; (c) "10" what (i.e., milliliters, grams, moles, etc.) is then being added; (d) what is meant by 1 of 10 mM solution of BODIPY-FL-SSE. The statement is fairly incomplete and very confusing because of these aspects of the statement. Furthermore, there is no closing parenthesis (i.e., there are four

Art Unit: 1636

open parenthesis, but only two closed parenthesis) in the first sentence. As such, everything after the first parenthesis is parenthetical in the entire specification, making it unclear what is actually the main part of the specification. The same error occurs starting on page 94, line 13, page 95, line 17, and page 95, line 27.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is drawn simply to "a method." There is no recitation of a purpose of the method in the preamble of the claim, therefore the metes and bounds of the method are indefinite. It is unclear if the claim is drawn to a method of creating a tRNA/marker conjugate, a method of incorporating a tRNA marker conjugate into a nascent protein, a method of detecting a nascent protein, or a method of isolating a nascent protein. As a result, it is unclear what steps comprise the method. Similarly, claims 2-5 are indefinite for not reciting a purpose in the preamble of the claim. Furthermore, if claim 1 is directed to a method of creating a tRNA/marker conjugate, then the purpose of claim 3 (apparently a method of detecting a nascent protein) is different from that of claim 1, and cannot properly depend from claim 1 as it does not further limit the independent claim. Additionally, if claim 1 is drawn to a method of detecting a nascent protein,

then claim 1 is incomplete as it does not recite a positive process step recapitulating the method as set forth in the preamble of the claim.

Claim 1 is rejected because it does not recite a positive process step referring to the preamble of the claim. Without such a step, it is unclear what the method is actually drawn to because there is no end to the method, thus the metes and bounds of the claim are indefinite. The method is further unclear in the absence of a positive process step referring to the preamble of the claim because there is no purpose for the method set forth in the preamble of the claim.

Claims 2 and 3 recite the limitation "said marker" in steps (c) and (d) of the claims. There is insufficient antecedent basis for this limitation in the claim. It is unclear if the term refers to the coumarin marker, or the tRNA/marker conjugate as the element that is incorporated into the nascent protein. Indicating "said coumarin marker" would be remedial.

***Allowable Subject Matter***

No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Application/Control Number: 09/813,197

Page 5

Art Unit: 1636

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson  
AU 1636

  
DAVID GUZO  
PRIMARY EXAMINER